

**REMARKS**

Claims 13-16 are all of the claims pending in the application; each of the claims has been rejected.

Claims 13, 14 and 16 have been amended to make clear that the RNA transcript recited therein *corresponds* to the selected DNA sequence. The skilled artisan would understand that because the RNA transcript is of the same sequence (except for the substitution of uracil for thymidine) as the selected DNA molecule, use of the term “complementary” in this regard was somewhat confusing. The use of “correspond” in this context can be found in the specification, such as at page 3, line 18.

Claim 13 has been amended to more clearly recite that which Applicants regard as their invention by reformatting the claim.

Claims 13 and 14 have been amended to add an element of repeating the obtaining and screening of RNA transcripts. Support for the amendments may be found in the specification at page 5, line 23 through page 6, line 2, and in Example 1, where it is clear that the methods are repeated on more than one portion of a selected DNA molecule.

No new matter has been added. Entry of this amendment is respectfully requested.

**I. Rejection of Claims Under 35 U.S.C. §102**

At paragraph 1 of the Office Action, claims 13 and 16 are rejected under 35 U.S.C. §102(b) as being anticipated by Davey et al. (U.S. Patent No. 5,409,818, issued April 25, 1995).

The Examiner states that Davey et al. teaches a method for determining whether a selected DNA molecule encodes a gene expression region (a 92 bp segment of the gag protein of the HTLV-III genome), comprising the steps set forth at pages 2-4 of the Office Action.

Applicants note that claim 13 recites a method of determining whether a selected DNA molecule encodes a gene expression region (i.e., an open reading frame). In contrast, Davey et al. simply discloses a method amplifying nucleic acid sequences. In contrast to the Examiner's position, there is no recognition in Davey et al. that the method taught therein could be used to determine whether a selected DNA molecule encodes a gene expression region.

Furthermore, included herewith is an amendment to claim 13 such that element (C) has been added to the claim. With the inclusion of element (C), the method recited in claim 13 is repeated on successive portions of the selected DNA molecule. In contrast, Davey et al. does not teach repeating the screening process on successive DNA fragments of a selected DNA molecule. Instead, Davey et al. only teaches the use of the method to amplify one particular polynucleotide.

Applicants note that claim 16 also includes the repetition of the method recited therein on successive DNA fragments.

As Davey et al. does not teach each step of claim 13 or 16, because it does not include repetition of the method on successive fragments of the same (selected) DNA molecule, Davey et al. does not teach each element of the rejected claims.

Accordingly, Davey et al. does not anticipate claims 13 and 16, and Applicants therefore respectfully request reconsideration and withdrawal of this rejection.

## **II. Rejection of Claims Under 35 U.S.C. §103**

At paragraph 2 of the Office Action, claims 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Davey et al. in view of Wittwer et al. (U.S. Patent No. 6,503,720, issued January 2003).

The Examiner states that Davey et al. teaches the method set forth in claims 14 and 15, with the exception that Davey et al. does not teach all of step (c) of claim 14, namely, the use of an intercalating fluorescence dye. However, the Examiner contends that Wittwer et al. teaches such dyes, and that it would have been *prima facie* obvious to one of ordinary skill in the art to combine the method of Davey et al. with the use of the dye of Wittwer et al.

As with claim 13 above, included herewith is an amendment to claim 14 such that element (C) has been added to the claim. With the inclusion of element (C), the method recited in claim 13 is repeated on successive portions of the selected DNA molecule. In contrast, Davey et al. does not teach repeating the screening process on successive DNA fragments of a selected DNA molecule. Instead, Davey et al. only teaches the use of the method to amplify one particular polynucleotide.

As Davey et al. does not teach each step of claim 14, because it does not include repetition of the method on successive fragments of the same (selected) DNA molecule, Davey et al. does not teach each element of the claimed invention. Wittwer et al. does not teach any elements of the pending claims, but instead is related to probes. As Wittwer et al. does not cure the defects of Davey et al., neither Davey et al. nor Wittwer et al., alone or in combination, teach or suggest the instant invention.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

### III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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